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Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Re: **Application Serial No.:** 08/889,033
Confirmation No.: 2912
Applicants: Bartholomew J. Frazzitta, et al.
Title: Transaction System
Docket No.: D-1083

Sir:

Please find enclosed the Reply Brief of Appellants pursuant to 37 C.F.R. § 1.193(b) in triplicate, in response to the Examiner's Answer dated July 16, 2003, for filing in the above-referenced application.

This Application has been pending more than 5 years. Thus, it is respectfully requested that this Application be treated as a special case and be advanced out of turn by the Office, in accordance with MPEP § 708.01 (I).

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Reply Brief and any other fee due to Deposit Account 04-1077.

Very truly yours,

Ralph E. Jocke
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I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 27th day of August 2003.

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Grouping of Claims

The Answer (at page 2), as best understood, alleges that claims 1-43, 45, and 47 "stand or fall together because Appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof." Appellants respectfully disagree. The Grouping of Claims section in the Appeal Brief is correct.

The Appeal Brief (at page 5, last paragraph) includes a Grouping of Claims section which states that "No groups of claims stand or fall together." Thus, the Appeal Brief includes a proper statement that the claims do not stand or fall together.

The Appeal Brief (in the "Argument" section thereof) also provides reasons in support of why the claims do not stand or fall together. For example, the Appeal Brief provides reasons how each claim recites additional features of the invention which distinguishes the claim over every other pending claim, and provides reasons how each of the claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

Separate arguments for respective claims 1-4, 12-13, 18-19, 24-27, 37-42, and 47 may be found beginning on Appeal Brief page 13. Separate arguments for respective claims 5-11, 14-16, 20-23, 28-36, and 43-46 may be found beginning on Appeal Brief page 65. The separate argument for claim 17 may be found beginning on Appeal Brief page 102.

Thus, the Appeal Brief includes both a proper statement that the claims do not stand or fall together and presents arguments why the claims are separately patentable. It follows that the Answer incorrectly interprets the Grouping of Claims section of the Appeal Brief.

Furthermore, where an Appeal Brief includes only one of either (a) a statement that the claims do not stand or fall together or (b) presents arguments why the claims are separately patentable, then the Appellants are to be notified of a noncompliance as per 37 C.F.R. § 1.192(d). Note MPEP § 1206 (August 2001 version at page 1200-11, col. 1, first paragraph). As previously discussed, the Appeal Brief (at page 5, last paragraph) includes a statement that the claims do not stand or fall together. However, Appellants were not notified of any noncompliance. Nor were Appellants given any appropriate time period to correct any alleged defects in accordance with 37 C.F.R. § 1.192(d). Thus, it must be concluded that the Appeal Brief (including the Grouping of Claims section thereof) is in compliance with 37 C.F.R. § 1.192(c). Appellants respectfully request that the Answer's incorrect assertions regarding the Grouping of Claims section of the Appeal Brief be disregarded.

Reply to the "Response to Argument" section of the Answer

The Answer includes a "Response to Argument" section beginning on page 9. Appellants respectfully submit that this section of the Answer does not address all of Appellants' arguments of record. The Appeal Brief contains many more reasons why the claims are allowable. Thus, please refer to the Appeal Brief for Appellants' additional arguments regarding all the issues of record.

Appellants respectfully disagree with the interpretation and application of the references. The Examiner's position on the few issues actually addressed is unsubstantiated by the prior art of record. Rather, the Answer merely makes conclusory statements. Again, please note the Appeal Brief for Appellants' more in depth discussion of all the issues of record.

The Casale in view of Bustos rejections

The Answer does not address all of Appellants' arguments regarding the rejections. The Answer at page 10, line 5 to page 12, line 4 substantially repeats the rejections presented at pages 3-5. Again, the rejections have already been fully addressed in the Appeal Brief.

Appellants' Appeal Brief shows that neither Casale nor Bustos teach or suggest the recited features and relationships. Nor would it have been obvious to have modified Casale with the teachings of Bustos. Furthermore, even if it were somehow possible (which it isn't) to have modified Casale with the teachings of Bustos, such a modification still would not have resulted in the recited invention. Therefore, Appellants' Appeal Brief shows that it would not have been obvious to have modified Casale with the teachings of Bustos as alleged to have produced the recited invention.

For example, with regard to claim 1, neither Casale nor Bustos, taken alone or in combination, disclose or suggest the recited customer station and service provider (SP) station, especially where the SP station and the customer station are positioned inside of the same building. Nor would it have been obvious to one having ordinary skill in the art to have modified Casale to have included a hotel room (104) (i.e., the alleged customer station in Bustos) inside of Casale's tiny building (10) (i.e., about the size of two typical parking spaces joined end-to-end; col. 5, lines 42-46).

For further example, with regard to claim 1, neither Casale nor Bustos, taken alone or in combination, disclose or suggest structure enabling a carrier to be selectively moved (with a transaction item) between a customer station and an SP station. Neither reference teaches or suggests transferring a carrier with a transaction item from a customer station to an SP station.

Returning to the Answer, at page 12 thereof some of Appellants' claim 1 arguments (Appeal Brief page 15) are addressed. For example, the Answer alleges that "the claimed features are obvious met by the elements in 1) 2), 3), and 4) . . . when Casale and Bustos are combined." The Answer, regarding feature 1), alleges that Casale alone "has disclosed the all limitations 1) (14 of fig. 1)." The Appellants respectfully disagree. Even the Answer admits (page 5, lines 14-15; page 11, lines 17-18) that Casale alone does not teach or suggest having a customer station inside a building. Hence, Casale cannot disclose feature 1) as indicated on Appeal Brief page 15.

As discussed in more detail in the Appeal Brief (e.g., pages 20-27) with regard to claim 1, Appellants specifically provide evidence that Casale desires that customers remain outside of the building; Casale's building is not structurally capable of supporting an interior "customer station"; Casale has no need of the recited "customer station"; and an interior customer station would destroy the disclosed benefits of Casale. Appellants also show that Bustos does not teach a customer station. Nevertheless, even if Bustos somehow did teach a customer station, Appellants further show that it would not have been obvious to one having ordinary skill in the art to have modified Casale to have included a customer station inside of Casale's small building. Such modification to Casale would be directly contrary to the explicit teaching of Casale, and would destroy the utility and structure of Casale's system. Appellants have also shown in the Appeal Brief that even if it were somehow possible to combine the references (which it isn't), the combination still would not have resulted in the recited invention.

The Answer has also failed to provide any valid explanation as to how the alleged customer station (i.e., hotel room 104) in Bustos could have structurally been inserted inside of

Casale's small building (10) (i.e., about the size of two typical parking spaces joined end-to-end; col. 5, lines 42-46). Nor has the Answer shown how such an insertion would have been obvious to one having ordinary skill in the art. As discussed in the Appeal Brief, the building of Casale is too small in size to have included any customer station, especially Bustos' hotel room.

The attempts to combine the teachings of the references are attempts at hindsight reconstruction based on knowledge gleaned only from Appellants' disclosure. The record does not factually support nor establish any *prima facie* conclusion of obviousness.

The Answer further alleges that features upon which Appellants rely "customer to remain outside of the building" (Answer at page 13, last paragraph; page 14, lines 9-11) and "interior customer station would destroy the disclosed benefit of Casale" (Answer page 15, lines 6-9) are not recited in the rejected claims. The Answer's statements are not appropriate, because Appellants are not relying on these mentioned features as being in the claims. Rather, Appellants are discussing the teachings of the Casale reference, and why (based on these teachings) it would not have been obvious to have modified Casale as alleged to have produced the recited invention.

The Answer at page 16, lines 3-6, alleges that in Bustos the "pneumatic delivery (carrier) is able to be selectively moved with food and/or beverages (transaction item(s)) between the customer carrier delivery and receiving device and the Service Provider (40C of fig. 5D) and receiving device (video or audio (telephone) receiver)." The Appellants respectfully disagree. Claim 1 recites that "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device." As discussed in the Appeal Brief (e.g., pages 24-25), the described structure of Bustos is not intended to nor capable of transferring a carrier with a transaction item from a customer

station to an SP station. All of the described embodiments in Bustos disclose or suggest only moving a transaction item one-way. Bustos does not disclose or suggest moving transaction items two-ways. Thus, Bustos does not teach or suggest the recited features not found in Casale.

The Answer at page 16, last paragraph, alleges that in Bustos the SP station is "interpreted as the combined system of the hotel office, kitchen, and storage (col. 14, line 1-21, 110, 40c, 102, 123 of fig. 5D)." The Appellants respectfully disagree, as discussed in more detail in the Appeal Brief (e.g., page 26). The Answer's interpretation is analogous to alleging that the SP station is the entire planet. However, claim 1 indicates that the SP station is enabled to be operated by a service provider providing a transaction, and the SP station includes therein an SP carrier delivery and receiving device and at least one recited component. It is unclear how Bustos' hotel office (110) and kitchen (123), which are distantly spaced, can collectively constitute an SP station, especially the recited SP station. Nor has the Answer shown that Bustos' hotel office (110) has an SP carrier delivery and receiving device.

The Answer at page 17, lines 1-3, alleges that an obviousness rejection may be based on common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. Appellants respectfully submit that an assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Furthermore, a determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Appellants respectfully submit that the current record lacks substantial evidence support, as discussed in more detail in the Appeal Brief.

The Answer at page 17, lines 4-8, alleges that (in regard to claims 38, 41, and 47) Appellants have repeatedly argued the same features. The Appellants respectfully disagree. The claims are not the same, nor are Appellants' arguments the same. The Appeal Brief (at pages 29-47) sets forth how each claim recites features which distinguish the claim over the other claims, and also shows how each claim is patentably distinguished from the applied references. Nevertheless, even if Appellants' arguments against the claim rejections overlap, the Answer has not overcome the Appellants' showing that each claim is patentably distinguishable over the cited art.

The Answer at pages 17-21 addresses some of the dependent claims. Appellants respectfully submit that the Appeal Brief (e.g., pages 48-64) already fully discusses the issues involving these dependent claims and explains why these dependent claims are further allowable. The Answer broadly asserts that the references when combined teach the invention. The Appellants respectfully disagree. For example, neither Casale nor Bustos, taken alone or in combination, teach or suggest a customer station comprising a frame (e.g., claim 4). Nor do the references teach or suggest a building having a secure room, especially where an SP station is housed in the secure room and a customer station is disposed outside of the secure room (e.g., claim 18). The Answer (at page 19, last paragraph) simply asserts that "the room is inside the building as considered a secure room as suggested by Casale (10 of fig. 3)." However, element (10) in Casale is actually the building, not a secured room.

As previously discussed, the record lacks substantial evidence support. The rejections are based on allegations instead of concrete evidence in the record. For example, the rejections indicate (Answer at page 4, lines 12-15; and page 10, lines 18-20) that an SP station display "is in

supporting connection with said wall" because "the display is supposed to be connected to the wall." The Answer also misinterprets the claims, because it is a customer station component that is recited as being positioned in supporting connection with an interior wall (e.g., claim 38).

The Casale in view of Bustos and McClure rejections

The Answer admits (page 6, lines 15-18) that Casale in view of Bustos lack many of the recited features. For example, the Answer admits that "the combination of Casale and Bustos does not particularly disclose a cover is movably mounted on the frame and movable to enable access the opening in supporting to connect with the wall, a door frame, at least one hinge, a sub-frame, a shelf, at least one storage location as specified in claims 5-11, 14-16, 20-23, 28, and 43-46." The Answer relies on McClure as teaching these recited features. The Appellants respectfully disagree with the interpretation and application of the McClure reference. For example, as discussed in more detail in the Appeal Brief (e.g., pages 67-79), Appellants specifically show that McClure does not disclose a customer station having an interior building wall; McClure does not disclose a customer station having a cover with a component opening; McClure desires the customer to remain outside of the building; it would not have been obvious to insert the customer station of McClure into Casale/Bustos; and the combined teachings of McClure and Casale/Bustos still would lack the recited claim features.

Because McClure's customer station (10) is located outside of a building, it follows that McClure further cannot alleviate the admitted deficiencies of Casale in view of Bustos. Also, the alleged cover (36) in McClure is actually a door. The door has no opening. It follows that the door has no "component opening" (in contrast to claim 28). When McClure's door (36) is in an

overlying (closed) position no component is accessible (in contrast to claim 28). Furthermore, McClure's door (36) is not mounted in supporting connection with an interior wall of a building (in contrast to claim 6). Again, McClure cannot overcome the admitted deficiencies of Casale in view of Bustos.

Nor has the Answer explained how the customer station (10) in McClure could have been inserted inside of Casale's small building (10) (about the size of two typical parking spaces joined end-to-end; col. 5, lines 42-46). Nor would such an insertion have been obvious to one having ordinary skill in the art. As previously discussed, the building of Casale is too small in size to have included any customer station. The large customer station (10) of McClure further prevents such an insertion.

Including the teachings of McClure into the alleged combination of Casale/Bustos, if somehow possible, would have at best produced adding a banking customer station to the area exterior of Casale's building (10). However, the alleged cover (36) and frame of the banking customer station (10) would not be positioned upon an interior wall of Casale's building (10). Thus, McClure cannot overcome the admitted deficiencies of Casale in view of Bustos. Therefore, it follows that it would not have been obvious to have combined Casale, Bustos and McClure as alleged to have produced Appellants' recited invention.

The Answer at pages 22-25 addresses more of the dependent claims. Appellants respectfully submit that the Appeal Brief (e.g., pages 80-101) already fully discusses the issues involving these dependent claim and why these dependent claims are further allowable. The Answer again broadly asserts that the references when combined teach the invention. The Appellants respectfully disagree. As previously discussed, Casale's building is not structurally

capable of having an interior customer station, especially a hotel room (i.e., the alleged customer station in Bustos). Nor does Bustos teach or suggest a customer station inside a building in the manner recited. Nor does McClure teach or suggest a frame and cover in the manner recited. Nor would it have been obvious to one having ordinary skill in the art to have combined the dissimilar teachings of Casale, Bustos, and McClure. Nor has the Answer provided any motivation or suggestion for combining features of the cited references so as to produce Appellants' invention. Nor has the Answer explained how Casale could be modified without destroying the disclosed (structural and functional) teaching thereof. Nor has the Answer explained how the combination would have resulted in the recited invention.

The Answer at page 7, last paragraph, alleges that "specific mechanical shapes claimed are believed to be merely aesthetic design choice and are in any case not critical to the invention." The Appellants respectfully disagree. It is unclear how the Answer interprets the claims 5-11, 14-16, 20-23, 28, and 43-46 as reciting specific shapes, as alleged. The Appellants respectfully submit that the recited structural features are patentable.

Furthermore, the mention of Kaehler at Answer page 25, line 1 is confusing. The record shows that Kaehler has only been applied against claim 17. The Answer first addresses Appellants' remarks regarding claim 17 at page 25, line 11. Thus, Appellants respectfully request that the Answer's erroneous mentioning of Kaehler at Answer page 25, line 1 be disregarded.

The Casale in view of Bustos and McClure and Kaehler rejections

The Answer alleges that it would be obvious to modify Kaehler's computer (26) to the service station of the combination of Casale, Bustos and McClure for the purpose of storing data.

The Appellants respectfully disagree. Kaehler's alleged computer (26) is actually a data entry terminal (col. 5, line 50). Kaehler does disclose a central control computer (16) (col. 6, lines 27-28). However, Kaehler does not disclose or suggest the recited computer, data store, and video material relationship. Furthermore, Kaehler is directed to a fuel dispenser system for selling fuel. Kaehler is non-analogous art. Even if it were somehow possible for Kaehler to have taught the recited relationship, the Answer is silent as to how Kaehler's fuel dispenser system could be implemented into the combination of Casale, Bustos, and McClure. For example, it is unclear how Kaehler's fuel dispenser system could be implemented into Casale's drive-thru fast food establishment. Having food (via a pick-up window) and fuel close together raises the possibility of health concerns. The Answer procedurally fails to establish a prima facie case of obviousness.

Nevertheless, the Answer is silent as to a video switching device in operative connection with a video presenting device, and how it could be implemented into the combination of references to produce Appellants' recited invention. There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention. Again, the Answer procedurally fails to establish a prima facie case of obviousness.


Conclusion

As previously discussed, the position of the Office in the Answer is based on broad unsubstantiated conclusory allegations rather than evidence of record. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The Answer's assertions are not based on any evidence presented in the record. *In re Zurko*, supra. *In re Lee*, supra. The record does not factually support any *prima facie* conclusion of obviousness. Nor does the Action follow *Graham v. John*

Deere Co. in the consideration and determination of obviousness. Thus, the Action also has not met the basic criteria for establishing a *prima facie* case of obviousness.

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



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